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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,872

09/30/2005

Akihiro Ohashi

357356US99PCT

2013

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7590

04/20/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BOYLE, ROBERT C

ART UNIT

PAPER NUMBER

1764

NOTIFICATION DATE

DELIVERY MODE

04/20/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/551,872	Applicant(s) OHASHI ET AL.	
	Examiner ROBERT C. BOYLE	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1764

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. No new grounds of rejection have been introduced, therefore this action is properly deemed FINAL.

Claim Objections

3. The objections presented in the previous Office Action are withdrawn in view of the amendments.

Claim Rejections - 35 USC § 112

4. The 112 second paragraph rejections presented in the previous Office Action are withdrawn in view of the amendments.

Claim Rejections - 35 USC § 103

5. Claims 1, 3-5, 7, 10-11, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sugihara** (US 2002/0017734) in view of **Ahara** (JP 09-208740).
6. The rejection is adequately set forth in paragraphs 11-19 in the office action mailed on 11/1/2010 and is incorporated here by reference.
7. Claims 2, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sugihara** (US 2002/0017734) in view of **Ahara** (JP 09-208740) and **Ozeki** (US 5,760,144). The rejection

Art Unit: 1764

is adequately set forth in paragraphs 20-26 in the office action mailed on 11/1/2010 and is incorporated here by reference.

8. Claims 2, 6, 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sugihara** (US 2002/0017734) in view of **Ahara** (JP 09-208740) and **McCarthy** (US 5,883,199). The rejection is adequately set forth in paragraphs 27-33 in the office action mailed on 11/1/2010 and is incorporated here by reference.

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sugihara** (US 2002/0017734) in view of **Ahara** (JP 09-208740) and **Staendeke** (US 4,957,950). The rejection is adequately set forth in paragraphs 34-38 in the office action mailed on 11/1/2010 and is incorporated here by reference.

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sugihara** (US 2002/0017734) in view of **Ahara** (JP 09-208740) and **Takahashi** (US 4,859,741). The rejection is adequately set forth in paragraphs 39-43 in the office action mailed on 11/1/2010 and is incorporated here by reference.

11.

Response to Arguments

12. Applicant's arguments filed 3/1/2011 have been fully considered but they are not persuasive.

Sugihara

Art Unit: 1764

13. Applicant argues that the amount of fine particles added by Sugihara is 0.1-5 wt% and not 5-50 wt%. Paragraph 99 of Sugihara recites:

The addition amount of these fine particles is preferably 0.1 to 5 wt % against the raw material resin. Furthermore, considering the contamination of the hopper of the injection molding machine, deposits of powder on the product surface and the wear of the screw, these fine particles may be used after being processed into a masterbatch containing 5 to 50 wt % of fine particles using resin, wax or rubber as the base material, for example.

14. It is clear that Sugihara appears to teach two ranges, 0.1-5 wt% and not 5-50 wt%.

However, it is the examiner's position that the second range, 5-50 wt%, encompasses the amount of the fine particles being added to the composition in view of the phrase "containing 5 to 50 wt % of fine particles using resin". The presence of the second range provides more than one embodiment present in Sugihara. A preferred embodiment is not controlling, rather, all disclosures "including unpreferred embodiments" must be considered. In re Lamberti 192 USPQ 278, 280 (CCPA 1976) citing In re Mills 176 USPQ 196 (CCPA 1972). Because this teaching overlaps the claimed range and teaches the amount of fine particles added to the resin, Sugihara obviates the instant claims.

15. Even if the Applicant's argument were correct, the amounts of Sugihara would still obviate the instant claims because the range of 0.1 to 5 wt % overlaps the claimed range of 5 to 40 mass parts phr. It is well settled that where prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See MPEP 2144.05; In re Harris, 409, F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); In re Peterson, 315 F.3d 1325, 1329, 65 USPQ 3d 1379, 1382 (Fed. Cir 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1990); In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). In light

Art Unit: 1764

of the cited patent case law, it would therefore have been obvious that in this particular instance to use the claimed amounts.

16. Therefore, because both ranges read on the instant claims, the Applicant's arguments are not persuasive.

Ahara

17. The range taught by Ahara (0.3 wt% or less Na₂O) overlaps the claimed range. It is well settled that where prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See MPEP 2144.05; *In re Harris*, 409, F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 3d 1379, 1382 (Fed. Cir 1997); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). In light of the cited patent case law, it would therefore have been obvious that in this particular instance to use the claimed amounts.

18. While Ahara does not disclose all the features of the present claimed invention, Ahara is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, MPEP 2145; *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973); *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, the claimed inorganic particles, and in combination with the primary reference, discloses the presently claimed invention. Thus, it is not

Art Unit: 1764

necessary for Ahara to teach the claimed amount of metal hydroxide, as Sugihara teaches this limitation (see above discussion).

19. As discussed above, the claimed range is obviated by the teaching of Sugihara in ¶ 99. Sugihara teaches that the amount of fine inorganic particles are present in the resin in amounts of 5-50 wt% or 0.1-5 wt%. Both of these ranges overlap the claimed range. Thus, the cited reference combination does make all the elements of the claimed invention known, and a prima facie case of obviousness has been presented.

20. Applicant's discussion regarding the remaining rejections relies on the basis discussed above. As such, these arguments are not persuasive for the reasons discussed above.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1764

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. BOYLE whose telephone number is (571)270-7347. The examiner can normally be reached on Monday-Thursday, 9:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Boyle/
Examiner, Art Unit 1764

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1764